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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,286	12/20/2001	Matthew J. Dejneka	SP01-371	1375

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CORNING INCORPORATED
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EXAMINER

DO, PENSEE T

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,286	Applicant(s) DEJNEKA ET AL.	
	Examiner Pensee T. Do	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-17,19,20 and 22-57 is/are pending in the application.
- 4a) Of the above claim(s) 26-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-17,19,20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3,5-17,19,20 and 22-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/17/05 & 4/8/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment Entry & Claim Status

The amendment filed on April 8, 2005 has been acknowledged and entered.

Claims 1, 3, 5-17, 19, 20, 22-25 are being examined. Claims 26-57 are withdrawn from further consideration.

Withdrawn Rejection(s)

Rejection under 112, 2nd in the previous office action is withdrawn herein.

Rejection under 102(b) by Oyobe is withdrawn herein.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 5-17, 19, 20 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for reciting "adapted to" because it is unclear of how the unique identification code is modified to be adapted to identify a functional group attached thereto.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1, 3, 5-17, 19, 20, 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new limitation of claim 1 recites that "whereby the particle has a diameter of between 10 microns and 100 microns". Applicant points out the support for this limitation in the specification at page 10, paragraph [0032] which describes that "the perform can be drawn into a fiber having a diameter or cross sectional dimension less than about one millimeter, and preferably on the order of about 10 to 100 microns". Apparently, the dimension taught by the specification is for the cross-section of a fiber, not the dimension of the claimed glass particle recited in claim 1.

Maintained Rejection(s)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kardos et al. (US 6,159,686).

Kardos teaches a label comprising of phosphor particles derived from phosphor host materials, each doped with at least one activator couple. Suitable host materials are sodium yttrium fluoride, lanthanum fluoride; etc... Suitable activator couples are ytterbium/erbium, ytterbium/thulium; and ytterbium/holmium. By combination of host materials with activator couples, at least three phosphors with at least three different emission spectra are provided. Since Kardos teaches doping the particle with rare earth materials, it is inherent that Kardos provides a unique identification code. The phosphor host materials each doped with at least one activator couples as described above are the means of providing a unique identification code and it is also inherent that the rare earth materials are arranged in a pattern to provide the unique identification code because Kardos teaches using a combination of rare earth materials such as activator couples as described above. Generally, the absorber is ytterbium and the emitting center can be selected from erbium, holmium, terbium, and thulium. (see col. 14, lines 15-63). The phosphor particles can be coated with a polycarboxylic acid and various proteins (immunoglobulin, streptavidin, or protein) can be physically adsorbed to the surface of the phosphor particles. Probes such as proteins or polynucleotides may be directly attached to the phosphor by covalent linkage. (see col. 13, lines 13-30). A water-insoluble polyfunctional polymer which exhibits glass can be used to coat the up-converting phosphors. (see col. 19, lines 9-12). The phosphor particles have a diameter of about 0.01 to 3 microns and larger or smaller particles can be used. (see col. 17, lines 31-32). Thus, it is inherent that the particle diameter can reach 10 to 100 microns since Kardos teaches that larger particles (than 3 microns) can be used.

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Remarks

Claims 5-15, 19, 20, 22-25 are free of prior arts.

Response to Arguments

Applicant's arguments filed on April 8, 2005 have been fully considered but they are not persuasive.

Regarding the rejection by Kardos, Applicants argue that Kardos fails to teach a particle having a diameter in the claimed range, between 10 and 100 microns.

Kardos teaches, on col. 17, lines 31-32, that the diameter for the phosphor particles is about 0.01 to 3 microns. Larger particles than such range can also be applied. (see col. 17, lines 31-32). Thus, it is inherent that larger particles taught by Kardos can fall in the claimed range, assuming such range is supported in the present specification.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 703-308-4398. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
July 06, 2005


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800/1491
7/11/05